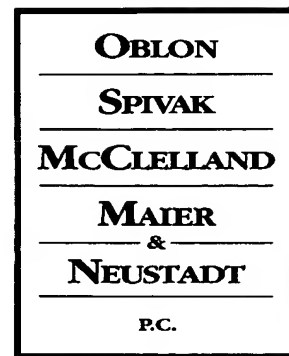




Docket No.: 242417US3



ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/654,891
Applicants: Masato KAWASAKI
Filing Date: September 5, 2003
For: APPARATUS AND METHOD FOR PREPARING
AND SUPPLYING SLURRY FOR CMP MACHINE
Group Art Unit: 1723
Examiner: T. SOOHOO

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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DOCKET NO: 242417US3



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MASATO KAWASAKI : EXAMINER: T. SOOHOO
SERIAL NO: 10/654,891 :
FILED: SEPTEMBER 5, 2003 : GROUP ART UNIT: 1723
FOR: APPARATUS AND METHOD FOR :
PREPARING AND SUPPLYING SLURRY
FOR CMP MACHINE

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated March 25, 2005, Applicant provisionally elects, with traverse, Group I, Claims 1-5 drawn to an apparatus for supplying slurry classified in class 366, subclass 152.1. The Applicant reserves the right to file one or more divisional applications directed to the non-elected Group II.

Applicant further respectfully traverses this Requirement for the reasons that Groups I and II have not been shown to be distinct in the manner required by the MPEP §806.05(e) and because no serious burden has been shown to be present here as to examining all of Claims 1-11 together.

With regard to showing distinctness, MPEP §806.05(e) requirements for establishing distinctness between a process and the apparatus for practicing the process were correctly noted as requirements "(1)" and "(2)" in the Restriction Requirement. However, the Restriction Requirement then errs in suggesting that the apparatus of Group I (Claims 1-5) "may be used to make cement slurry" and in suggesting that "the process [presumably as

recited by Claims 6 and 7 of Group II] can be practiced without dampers and pressurization valves.”

The suggestion that the apparatus of Group I Claims 1-5 “may be used to make cement slurry” ignores that this apparatus is not just recited as making the “slurry” as the claimed apparatus must also supply the “slurry” to “said chemical polishing machine.” The “slurry” must contain more than one liquid component, unlike cement, and it must have “a dispersion of fine abrasive particles” for performing the polishing.

The further suggestion that “the process [presumably as recited by Claims 6 and 7 of Group II] can be practiced without dampers and pressurization valves is wrong because Claim 6 depends from Claim 1 and/or incorporates Claim 1 subject matter at line 5 there-of while Claim 7 depends from Claim 6.

Accordingly the required showings of distinctness presented by MPEP §806.05(e) have not been made and the Requirement is traversed.

Applicant further respectfully traverses the outstanding Restriction Requirement on the grounds that the Restriction Requirement has not established that searching and examining Claims 1-7 together places an undue burden on the Examiner in light of the incorporation of Claim 1 subject matter into Claim 6 as noted above.

M.P.E.P. § 803 specifically states:

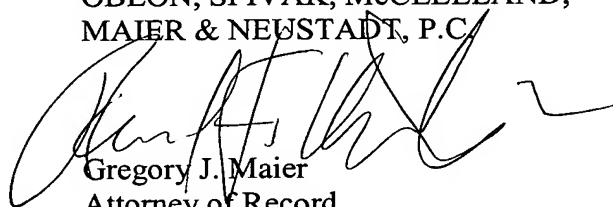
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Application No. 10/654,891
Reply to Office Action of March 25, 2005

Claims 1-7 of the present invention would appear to be part of an overlapping search area. Therefore, Applicant respectfully traverses the outstanding Restriction Requirement on the grounds that a search and examination of the entire application would not place a serious burden on the Examiner. Accordingly, an action on the merits is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over the printed name and firm information.

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